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**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

In The Matter of an *ex parte* Petition  
for Judicial Assistance Pursuant to 28  
U.S.C. § 1782, by

CPC Patent Technologies PTY Ltd.,  
Petitioner,

In support of legal proceedings in the  
Federal Republic of Germany

Case No. 5:21-mc-80091

**MEMORANDUM OF LAW IN  
SUPPORT OF CPC PATENT  
TECHNOLOGIES PTY LTD.'S  
PETITION FOR AN *EX PARTE*  
DISCOVERY ASSISTANCE  
ORDER PURSUANT TO 28 U.S.C. §  
1782(a)**

## I. Introduction

Petitioner, CPC Patent Technologies PTY Ltd. (“CPC”) submits this Memorandum of Law in support of its Petition for an *Ex Parte* Order authorizing it to obtain discovery from Apple, Inc. (“Apple”) for use in contemplated patent infringement proceedings in the Federal Republic of Germany (“the Foreign Proceedings”) pursuant to 28 U.S.C. § 1782(a). Specifically, CPC seeks an Order allowing it to serve a subpoena *duces tecum* for the documents identified in Exhibit A, hereto, to support the Foreign Proceedings.

## II. Preliminary Statement

CPC is the owner by assignment of a patent portfolio directed generally to biometric security in the access to, *inter alia*, electronic devices. CPC has initiated a patent infringement action against Apple in a matter styled *CPC Patent Technologies PTY Ltd. v. Apple, Inc.*, 21-cv-00165 (W.D. Tex.) (“the Texas Litigation”). The complaint in that matter is attached hereto as Exhibit B. The patents at issue in the Texas Litigation are U.S. Patent Nos. 9,269,208 (“the ‘208 Patent”), 9,665,705 (“the ‘705 Patent”), and 8,620,039 (collectively “the U.S. Patents”). See Ex. B, ¶ 1. The products accused of patent infringement in that case are electronic devices with biometric security measures, such as iPhones, iPads, and personal computers.

CPC intends to file suit for patent infringement against Apple Retail Germany B.V. & Co. KG in Germany, asserting the German patent corresponding to the ‘705 Patent. CPC therefore seeks discovery pursuant to 28 U.S.C. § 1782(a), which provides, in pertinent part:

The district court of the district in which a person resides or is found may order him to give his testimony or statement . . . for use in a proceeding in a foreign or international tribunal . . . . The order may be made . . . upon the application of any interested person and may direct that the testimony or statement be given . . . before a person appointed by the court. . . . The order may prescribe the practice and procedure . . . for taking the testimony or statement . . . . To the extent that the order does not prescribe otherwise, the

1 testimony or statement shall be taken, and the document or other thing  
2 produced, in accordance with the Federal Rules of Civil Procedure.

### 3 **III. Argument**

4 The language of section 1782(a) “has been distilled to permit district courts to  
5 authorize discovery where three general requirements are satisfied: (1) the person from  
6 whom the discovery is sought ‘resides or is found’ in the district of the district court  
7 where the application is made; (2) the discovery is ‘for use in a proceeding in a foreign  
8 or international tribunal’; and (3) the application is made by a foreign or international  
9 tribunal or ‘any interested person.’” *Khrapunov v. Prosyankin*, 931 F.3d 922, 925 (9th  
10 Cir. 2019). Once those three statutory requirements are met, a district court has wide  
11 discretion to grant discovery under section 1782. *Intel Corp. v. Advanced Micro*  
12 *Devices, Inc.*, 542 U.S. 241, 260-61 (2004); *Four Pillars Enters. Co. v. Avery Dennison*  
13 *Corp.*, 308 F.3d 1075, 1079 (9th Cir. 2002).

14 In exercising its discretion, a district court should be guided by the following  
15 factors: (1) whether the “person from whom discovery is sought is a participant in the  
16 foreign proceeding;” (2) “the nature of the foreign tribunal, the character of the  
17 proceedings underway abroad, and the receptivity of the foreign government or the  
18 court or agency abroad to U.S. federal court judicial assistance;” (3) whether the request  
19 “conceals an attempt to circumvent foreign proof-gathering restrictions or other policies  
20 of a foreign country or the United States;” and (4) whether the request is “unduly  
21 intrusive or burdensome.” *Intel*, 542 U.S. at 264-65. However, a district court need not  
22 explicitly address every factor, nor is it confined to the four *Intel* factors in deciding  
23 whether to exercise its broad discretion. *See Akebia Therapeutics, Inc. v. Fibrogen, Inc.*,  
24 793 F.3d 1108, 1112 (9th Cir. 2015), *citing United States v. Sealed 1*, 235 F.3d 1200,  
25 1206 (9th Cir. 2000).

26 A district court’s discretion is to be exercised in view of the twin aims of section  
27 1782, “providing efficient assistance to participants in international litigation and  
28

1 encouraging foreign countries by example to provide similar assistance to our courts.”  
 2 *Intel*, 542 U.S. at 252 (citation and internal quotation marks omitted).

3 In order to obtain relief under section 1782, a petitioner must satisfy three  
 4 statutory prerequisites: (1) the person from whom discovery is sought resides or is  
 5 found in the district; (2) the discovery is for use in a proceeding before a foreign  
 6 tribunal; and (3) the application is made by a foreign or international tribunal or any  
 7 interested person. *In re Kleimar N.V.*, No. 17-cv-01287, 2017 WL 3386115, at \*4 (N.D.  
 8 Ill. Aug. 7, 2017).

9 Additionally, a court can consider four discretionary factors in deciding whether  
 10 to grant a section 1782(a) application: (1) whether the testimony sought is within the  
 11 foreign tribunal’s jurisdictional reach, and thus accessible absent section 1782  
 12 assistance; (2) the nature of the foreign tribunal, the character of the proceedings  
 13 underway abroad, and the receptivity of the foreign government or the court or agency  
 14 abroad to U.S. federal-court judicial assistance; (3) whether the section 1782 request  
 15 conceals an attempt to circumvent foreign proof-gathering restrictions or other policies  
 16 of a foreign country or the United States; and (4) whether the subpoena contains unduly  
 17 intrusive or burdensome requests. *Id.*; *Intel* 542 U.S. at 264-65. In any case, courts “err  
 18 on the side of permitting discovery” under section 1782. *See In re Varian Medical Sys.*  
 19 *Int’l AG*, No. 16-mc-80048-MEJ, 2016 WL 1161568 at \*4 (N.D. Cal. Mar. 24, 2016).

20 **A. The Documents Requested are Located in this Judicial District**

21 Apple’s headquarters are located in this Judicial District. Apple has been  
 22 headquartered in Cupertino, California since 1976. *In re Apple, Inc.*, 743 F.3d 1377,  
 23 1379 (2014) (Newman, J, Dissenting). Apple’s management and primary research and  
 24 development facilities are also located in Cupertino where Apple employs over 13,000  
 25 people. *Id.* at 1379-80. The research, design, and development of the iPhone took place  
 26 in Cupertino and virtually all Apple business documents and records relating to the  
 27 research, design, development, marketing strategy, and product revenue for the accused  
 28 products are located in or near Cupertino. *Id.* at 1380.

**B. The Evidence Sought is for Use in a Foreign Tribunal**

The documents sought from Apple are for use in a foreign tribunal. *See, e.g., AIS GmbH v. Aachen Innovative Sols. v. Thoratec LLC*, 762 F. App'x 447, 448 (9th Cir. 2019) (German courts adjudicating patent infringement matters are foreign tribunals).

**C. The Evidence is Sought by an Interested Person**

CPC is an “interested person” within the meaning of section 1782(a). *See Intel*, 542 U.S. at 256 (“interested person” includes “litigants before foreign or international tribunals”).

**D. Apple is not a Party to the Foreign Proceeding**

Apple will not itself be a party to the litigations in Germany, although a company related to it will be. A court will more freely grant a petition under section 1782(a) where the evidence in question is sought from a third party. *Intel*, 542 U.S. at 264-65.

**E. The German and Australian Courts Would Consider the Subject Evidence**

German courts are receptive to receiving evidence obtained in the United States via section 1782. *Illumina Cambridge Ltd. v. Complete Genomics, Inc.*, 19-mc-80215, Order (N.D. Cal. Feb. 19, 2020) [ECF Docket No. 42] (Ex. C) at 7.

**F. The Petition Does Not Conceal an Attempt to Circumvent Foreign Proof Gathering Restrictions**

There is no evidence that German courts prohibit the discovery sought in the instant petition. *See, e.g., Illumina Cambridge*, Order at 9, citing *In re IPCom GmbH & Co.*, 2014 WL 12772090 at \*3 (N.D. Cal. Apr. 10, 2014) (noting there is no circumvention because “U.S. courts have routinely granted applications under Section 1782 for discovery of evidence to be used in German proceedings”).

**G. The Document Requests are not Unduly Burdensome**

Courts may consider whether discovery requests under section 1782 are “unduly intrusive or burdensome” and should be “rejected or trimmed.” *Intel*, 542 U.S. at 265. Here, CPC seeks documents regarding the development of discrete

1 features of particular consumer electronic devices. Further, the categories seek  
2 documents “sufficient to show” different aspects of such features, rather than  
3 seeking “all” documents related to such aspects. Under the circumstances, the  
4 subject requests are not unduly burdensome.

5 **IV. Conclusion**

6 For the foregoing reasons, this Court should grant CPC’s Petition  
7 pursuant to 28 U.S.C. § 1782(a) and issue an Order authorizing the requested  
8 discovery.

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10  
11 Dated: April 22, 2021

Respectfully submitted,

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